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P-3724-2-F1-C1-C1

IN THE SPECIFICATION

Please replace the paragraph beginning at page 24, line 23 with the following rewritten paragraph:

Other soft, relatively low modulus non-ionomeric thermoplastic elastomers may also be utilized to produce the outer cover layer as long as the non-ionomeric thermoplastic elastomers produce the playability and durability characteristics desired without adversely effecting the enhanced spin characteristics produced by the low acid ionomer resin compositions. Preferably, the non-ionomeric thermoplastic elastomers have a Shore D hardness of 64 or less. These include, but are not limited to thermoplastic polyurethanes such as: Texin[®] thermoplastic polyurethanes from Mobay Chemical Co. and the Pellethane[®] thermoplastic polyurethanes from Dow Chemical Co.; Ionomer/rubber blends such as those in Spalding U.S. Patents 4,986,545; 5,098,105 and 5,187,013; and, Hytrel[®] polyester elastomers from DuPont and Pebax[®] polyetheramides from Elf Atochem S.A.

REMARKS

Reconsideration of the application and entry of the amendment are respectfully requested. Claims 1 to 8 are currently pending, and no claims have been amended.

The Final Office Action mailed November 25, 2002 addressed claims 1 to 8. Claims 1 to 8 were rejected.

Claims 2 and 4 to 8 were rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner stated that the Shore D hardness less than 64 for the outer cover has not been disclosed.

Applicant respectfully submits that the Shore D hardness of less than 64 for the outer cover layer has been disclosed. Applicant respectfully submits that original claims 1 and 5 of a parent application, U.S. Patent Application Serial No. 08/556,237, filed on November 9, 1995, disclose "an outer cover layer having a Shore D hardness of 64 or less" and "an outer cover layer having a Shore D hardness of about 64 or less"

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respectively. Since the original claims are considered part of the specification, Applicant respectfully submits that the Shore D hardness of 64 or less has been disclosed. As required by the Examiner in the Final Office Action, the specification has been amended to include the hardness for the outer cover layer, and a copy of the originally filed claims is attached to this response. Applicant respectfully submits that this overcomes the rejection of claims 2 and 4 to 8 under 35 U.S.C. § 112, first paragraph. Applicant therefore respectfully requests that the rejection of claims 2 and 4 to 8 be reconsidered and withdrawn.

Claims 1 and 3 were rejected under 35 U.S.C. 103(a) as being unpatentable over Nesbitt in view of Sullivan '814 and Wu. The Examiner stated that Nesbitt discloses a golf ball comprising a core, an inner cover layer and an outer cover layer. The Examiner further stated that the inner cover layer has a thickness from 0.020 to 0.070 inches and is made from a high flexural modulus ionomer, and the outer cover has a thickness of from 0.020 to 0.10 inches and is made from a low flexural modulus ionomer. The Examiner further stated that the golf ball has an overall diameter of 1.68 inches, and the inner cover layer material may include Surlyn 1605 which has a 15% acid content. The Examiner further stated that Nesbitt does not disclose a blend of ionomers for the inner cover layer, but Sullivan teaches a blend of ionomers for the cover layer, and one skilled in the art would have included additional ionomers to improve the durability. The Examiner concluded that Nesbitt also does not disclose polyurethane for the outer cover, but Wu teaches a polyurethane cover, and one skilled in the art would have modified the cover material with polyurethane since it is known to provide good shear resistance, cut resistance, durability, and resiliency.

Applicant respectfully submits that the Examiner has failed to make out a *prima facie* case of obviousness. Nesbitt, the primary reference, discloses a golf ball comprising a core and an improved multi-layer cover. The inner cover layer comprises a single hard, high flexural modulus ionomer, and the outer cover layer comprises a soft, low flexural modulus ionomer. Nesbitt uses as examples Surlyn® 1605 and 1855 ionomers, high and low flexural modulus ionomers respectively. Nesbitt does not disclose a multi-layer cover where the inner cover layer comprises a blend of two or

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more ionomers wherein at least one ionomer is an ionomer containing no more than 16% by weight of an alpha, beta-unsaturated carboxylic acid and the outer cover layer comprises a polyurethane material.

Sullivan discloses a two piece golf ball having a core and a cover, wherein the cover is formed from a blend of a hard and a soft ionomer. The hard and soft ionomers are very specific ionomers, and the soft ionomer is a terpolymer. The two ionomers are blended in specific ratios. Sullivan does not disclose blending two ionomers wherein at least one of the ionomers contains no more than 16% by weight of an alpha, beta-unsaturated carboxylic acid.

Applicant respectfully submits that there is no motivation or teaching to combine Nesbitt and Sullivan. There is no motivation to substitute the single layer cover of Sullivan that comprises a blend of a hard ionomer and soft ionomer terpolymer for the single, high flex modulus ionomer of Nesbitt's inner cover layer, but even if it was substituted, a golf ball having an inner cover layer comprising a blend of ionomers wherein at least one of the ionomers comprises no more than 16% by weight of an alpha, beta-unsaturated carboxylic acid would not be produced. Additionally, Applicant respectfully submits that there is no motivation, teaching or suggestion in Sullivan to use a blend of ionomer resins of any type in an inner cover layer. Instead, the only specific teaching in Sullivan shows blends of ionomers in golf ball outer covers or single, thicker cover layers of two piece golf balls.

Wu is directed to a golf ball having a core and a single layer cover comprising a specific polyurethane. Wu does not disclose a multi-layer cover.

Since, as discussed above, the primary reference, Nesbitt, is deficient because it does not disclose a golf ball having a multi-layer cover, wherein the inner cover layer comprises a blend of two or more ionomers wherein at least one ionomer contains no more than 16% by weight of an alpha, beta-unsaturated carboxylic acid and the outer cover layer comprises a polyurethane material, the addition of Sullivan and/or Wu as a secondary reference does not cure this deficiency. Applicant respectfully submits that even if Sullivan is combined with Nesbitt, Sullivan is not directed to a blend of two or more ionomers wherein at least one ionomer contains no more than 16% by weight of

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an alpha, beta-unsaturated carboxylic acid, therefore the combination would not produce a golf ball having a cover layer containing blend of two or more ionomers wherein at least one ionomer contains no more than 16% by weight of an alpha, beta-unsaturated carboxylic acid. Furthermore, Applicant respectfully submits that one skilled in the art would not be motivated by Wu to add a polyurethane cover to Nesbitt because Nesbitt has a multi-layer cover with specific features, and Wu has a single layer cover. Even if both Sullivan and Wu were combined with Nesbitt, Applicant's golf ball would not be produced because neither Nesbitt alone as the primary reference, nor in combination with Sullivan and/or Wu, produces a golf ball comprising an inner cover layer comprising a blend of two or more ionomers wherein at least one ionomer contains no more than 16% by weight of an alpha, beta-unsaturated carboxylic acid and an outer cover layer comprising a polyurethane. Both Wu and Sullivan are directed to golf balls with single cover layers, therefore, there is no motivation to substitute either the blend of ionomers of Sullivan's single cover layer or the specific polyurethane of Wu's single cover layer for the inner cover layer of Nesbitt.

Furthermore, Applicant respectfully submits that a prior art patent, such as Nesbitt, Sullivan or Wu, must be considered as a whole, and it is impermissible to pick and choose from one reference only so much of it as will support a given position to the exclusion of other parts necessary for the full appreciation of what the reference fairly suggests to one skilled in the art. Applicant respectfully submits that the Examiner is picking and choosing cover materials from prior art patents directed to golf balls with a single layer cover in an attempt to recreate Applicant's invention. Applicant respectfully submits that the Examiner has not shown the motivation, teaching or suggestion to combine Sullivan and Wu with Nesbitt, and the only teaching is found in Applicant's own disclosure.

Finally, Applicant respectfully submits that one skilled in the art would not add the ionomer blend of Sullivan to the cover of Nesbitt because Sullivan's ionomer blend is a very specific blend of a hard ionomer and a soft terpolymer ionomer and the cover of Sullivan is a single layer, nor would one skilled in the art add the polyurethane of Wu to the cover of Nesbitt because the cover of Wu is a single layer and one would not

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add the single layer polyurethane cover of Wu to the multi-layer cover of Nesbitt since it would not necessarily achieve the same goals as a specific combination of cover layers such as that in Nesbitt.

For at least these reasons, Applicant respectfully submits that claims 1 and 3 are not obvious under 35 U.S.C. § 103(a) over Nesbitt in view of Sullivan and Wu. Applicant therefore respectfully requests that the rejection of claims 1 and 3 under 35 U.S.C. § 103(a) as obvious over Nesbitt in view of Sullivan and Wu be reconsidered and withdrawn.

Attached hereto is a marked-up version of the changes made to the application by this Amendment. The Examiner is invited to telephone Applicant's attorney if it is deemed that a telephone conversation will hasten prosecution of the application.

CONCLUSION

Applicant respectfully requests reconsideration and allowance of each of the presently rejected claims, claims 1 to 8. Applicant respectfully requests allowance of claims 1 to 8, the claims currently pending.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES
IN THE SPECIFICATION

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ATTACHMENT FROM 08/556,237 FILED 11/9/95

I claim:

1. A golf ball comprising:

a core;

an inner cover layer having a Shore D hardness of 60 or more molded on said core, the inner cover layer comprising a blend of two or more low acid ionomer resins containing no more than 16% by weight of an alpha, beta-unsaturated carboxylic acid; and

an outer cover layer having a Shore D hardness of 64 or less molded on said inner cover layer, said outer cover layer comprising a relatively soft polymeric material selected from the group consisting of non-ionomeric thermoplastic and thermosetting elastomers.

2. A golf ball according to claim 1, wherein the inner cover layer has a thickness of about 0.100 to about 0.010 inches and the outer cover layer has a thickness of about 0.010 to about 0.70 inches, the golf ball having an overall diameter of 1.680 inches or more.

3. A golf ball according to claim 1 wherein the inner cover layer has a thickness of about 0.050 inches and the outer cover layer has a thickness of about 0.055 inches, the golf ball having an overall diameter of 1.680 inches or more.

4. A golf ball according to claim 1 wherein the outer layer comprises a polyurethane based material.

5. A multi-layer golf ball comprising:

a spherical core;

5 an inner cover layer having a Shore D hardness of about 60 or more molded over said spherical core, said inner cover layer comprising an ionomeric resin including no more than 16% by weight of an alpha, beta-unsaturated carboxylic acid and having a modulus of from about 15,000 to about 70,000 psi;

10 an outer cover layer having a Shore D hardness of about 64 or less molded over said spherical intermediate ball to form a multi-layer golf ball, the outer layer comprising polyurethane based material.

8. A multi-layer golf ball comprising:

a spherical core;

5 an inner cover layer molded over said spherical core to form a spherical intermediate ball, said inner cover layer comprising an ionomeric resin having no more than 16% by weight of an alpha, beta-unsaturated carboxylic acid and having a modulus of from about 15,000 to about 70,000 psi;

an outer cover layer molded over said spherical intermediate ball to form a multi-layer golf ball, the outer layer

- 10 comprising a non-ionomeric elastomer selected from the group consisting of polyester elastomer, polyester, polyether polyurethane and polyester amide, said outer cover layer having a modulus in a range of about 1,000 to about 30,000 psi.